

### **REMARKS**

In the outstanding Office Action, claims 1, 3, 4, 11, 13, 14, and 16-19 were rejected under 35 U.S.C. § 102(b) and claims 2, 5-10, 20-45 were rejected under 35 U.S.C. § 103(a).

In the present Response, new claims 49-59 have been added. No new matter has been added in these new claims. Support for the claims can be found throughout the specification and the claims as filed. More specifically, support for independent claim 49 and dependent claims 50-52 can be found in the application as filed at page 10, line 1 through page 11, line 2. Further, support for independent claim 53 and dependent claims 54-58 can be found throughout the application as filed and in the claims as filed. In addition, support for independent claim 59 can be found in the application as filed at page 10, line 1 through page 11, line 2 and throughout the application and claims as filed.

Claims 12, 15, and 46-48 were previously cancelled. Claims 1-11, 13-14, 16-45, and 49-59 are currently pending.

#### **§ 102 Rejections**

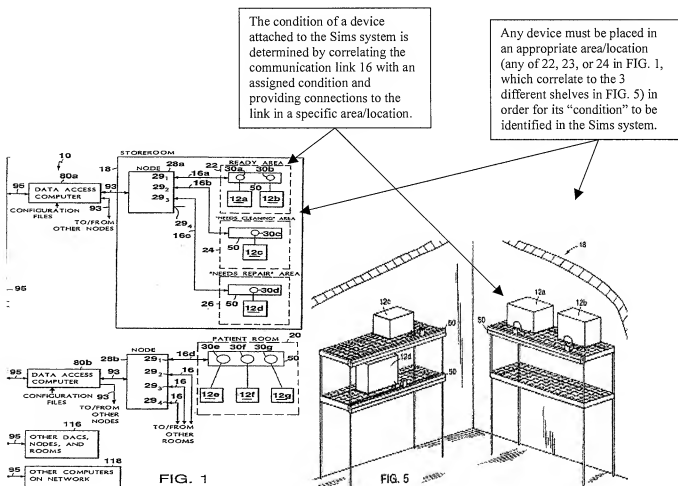
Claims 1, 3, 4, 11, 13, 14 and 16-19 were rejected under 35 U.S.C. § 102(b) as being anticipated by U.S. Patent No. 5,434,775 ("Sims"). Applicants respectfully disagree.

#### **Claim 1 Is Not Anticipated by Sims**

Claim 1 is directed to a system for managing a plurality of assets "wherein the physical condition of each of the plurality of assets is not determined based on the physical location of the asset."

In contrast, Sims fails to teach or suggest the invention of claim 1. Sims discloses a system wherein the physical condition of each asset is determined based on the physical location of the asset.

In Sims, FIGS. 1 and 5 (depicted below) disclose that the Sims system ties the physical condition of each asset directly to the physical location of each asset. That is, in order for the Sims system to assign a particular condition to a particular device, the device must be placed in the appropriate location.



Note the following passages from Sims with respect to FIGS. 1 and 5:

"Each communication link 16 corresponds to a location in the hospital. . . . Some communication links (such as links 16a, 16b, and 16c) *also correspond to various conditions of devices 12* stored in room 18." Col. 5, ll. 10-16.

"[N]odes 28 can group devices 12 based on the ports 291-294 to which the device tags 30 are connected. A particularly useful

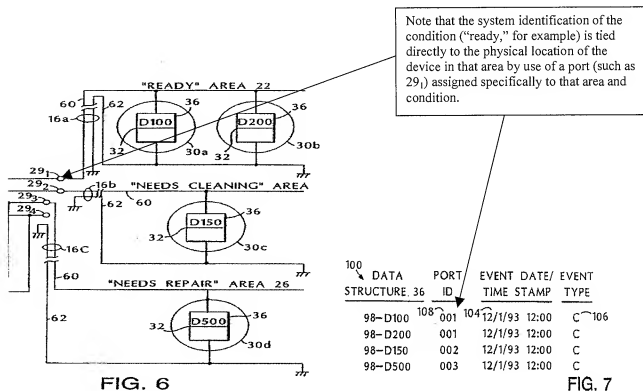
implementation of this feature is to ***associate each port 29<sub>1</sub>-29<sub>4</sub> with a different condition (or status) that devices 12 may have.*** For example, port 29<sub>1</sub> of node 28a is assigned to devices 12 located in storeroom 18 that are ready for use, port 29<sub>2</sub> is designated for devices 12 that are in need of cleaning, and port 29<sub>3</sub> is associated with devices that require repair.” Col. 6, ll. 34-43.

To assign a condition to a device, “a user who places a device 12 in any room 18, 20 ***need do no more than place device 12 in the appropriate area*** (such as on ‘ready’ shelf 22 in storeroom 18 or on an IV post in patient room 20) and insert tethered tag 30 into connector 50. Transparently to the user, ***node 28 assigned to the room reads data structures 36 and correlates it with the identity of the port 29 on which data structure 36 is read.***” Col. 7, ll. 50-58.

Again, it is clear based on the above figures and passages that in order for the Sims system to assign a particular condition to a particular device, the device must be placed in the appropriate location. For example, for device 12a to be designated as “ready,” it must be placed on the top shelf on the right in FIG. 5, while device 12c must be placed on the top shelf on the left in FIG. 5 in order to be designated as “needs cleaning.” Hence, the condition of any device tracked in the Sims system is tied directly to the physical location of the device.

While it was asserted in the outstanding Office Action that Sims discloses the invention of claim 1, it is respectfully submitted that the above discussion clearly establishes that Sims does not disclose the invention. Applicants respectfully invite the Examiner to identify any portion of Sims that discloses a system wherein the physical condition of any asset is not determined based on the physical condition of the asset.

Although a specific Sims passage regarding FIG. 7 was cited in the Office Action as providing support for the assertion that Sims anticipates claim 1, the cited passage actually supports and even emphasizes that the condition of any device tracked in Sims is tied directly to the physical location of the device. Please refer to the three areas (22, 24, and 26) depicted in FIGS. 1 and 6 which are discussed in FIG. 7 (depicted below).



Referring to FIG. 7 (in the passage quoted in the outstanding Office Action), it is stated in Sims that "[p]rocessor 90 determines that tags 30a, 30b with the data structures D100 and D200 are connected to port 291 (by communication link 16a), which corresponds to 'ready' area 22 of storeroom 18. Similarly, processor 90 detects that tag 30c (address D150) is connected (via link 16b) to port 292 (which corresponds to 'needs cleaning' area 24 of storeroom 18). Finally, processor 90 detects that tag 30d (address D500) is connected to port 293 (which corresponds to 'needs repair' area 26 of storeroom 18). Thus, each entry 98 identifies a data structure 36, a location code 108 of '001' and a connect ('C') event type." Col. 10, ll. 6-17.

Thus, FIG. 7 and the description above in Sims make it clear that the condition of any device tracked in Sims is tied directly to the physical location of the device.

As such, Sims fails to teach or suggest a system “wherein the physical condition of each of the plurality of assets is not determined based on the physical location of the asset.” Sims, therefore, does not anticipate claim 1. Reconsideration and withdrawal of the rejection is respectfully requested.

*Claims Depending from Claim 1 Are Not Anticipated by Sims*

Because claims 2-11, 13-14, and 16-19 depend directly or indirectly from claim 1 and incorporate all the limitations of claim 1, the above argument obviates the basis for these grounds of rejection. Thus, claims 2-11, 13-14, and 16-19 are not anticipated by Sims. Reconsideration and withdrawal of the rejections are respectfully requested.

**§ 103 Rejections**

Claims 2, 5-10 and 20-45 were rejected under 35 U.S.C. § 103(a) as being unpatentable over Sims in view of an article written by Karen Dilger (Dilger, Karen Abramic, “Asset management, maintenance redefined,” Manufacturing Systems, vol. 15 no. 7, pp. 122-128, July 1997) (“Dilger”) and/or U.S. Patent 5,918,207 (“McGovern”). Applicants disagree.

*Independent Claims 1, 20, 30, and 38 Are Not Unpatentable Over Sims in view of Dilger and/or McGovern*

As discussed above with respect to claim 1, each of claims 1, 20, 30, and 38 are directed to separate inventions wherein the physical condition of each asset is not determined based on the physical location of the asset.

As also discussed in detail above, Sims fails to teach or suggest a system wherein the physical condition of each asset is not determined based on the physical location of the asset. Instead, the device tracking in Sims, including any physical condition of the device that is tracked, is based solely on the physical location of the device. As such, Sims does not teach or suggest the invention of claims 1, 20, 30, or 38.

Dilger fails to remedy the deficiencies of Sims. That is, Dilger fails to teach or suggest a system or method wherein the physical condition of each asset is not determined based on the physical location of the asset. In fact, Dilger is relied upon in the Office Action solely for assertedly disclosing use of the Internet, access to a system using web browsing techniques in order to allow users to access the system from anywhere, and receiving a service request at a website for an asset. Thus, Dilger does not teach or suggest a system or method wherein the physical condition of each asset is not determined based on the physical location of the asset.

Regardless, as discussed in Applicants' May 10, 2006 Response, Dilger does not teach or suggest an asset management system for managing a plurality of assets of one or more enterprises. More specifically, it is respectfully submitted that Dilger fails to teach or suggest any of the pending claims, because Dilger is not enabled with respect to the disclosures upon which the Examiner relies.

As the Examiner knows, a prior art reference can only serve as an anticipating reference if it enables "that which it is asserted to anticipate." *Elan Pharm., Inc. v. Mayo Foundation for Medical Educ. and Research*, 346 F.3d 1051, 1054 (Fed. Cir. 2003). More specifically, the reference "must teach one of ordinary skill in the art to make or carry out the claimed invention without undue experimentation." *Id.* (quoting *Minnesota Mining and Mfg. Co. v. Chemque, Inc.*, 303 F.3d 1294, 1301 (Fed. Cir. 2002)). In fact, "even if the claimed invention is disclosed in a printed publication, that disclosure will not suffice as prior art if it is not enabling." *Id.* at 1055 (quoting *In re Donohue*, 766 F.2d 531, 533 (Fed. Cir. 1985)).

None of claims 1, 20, 30, or 38 are unpatentable in view of Dilger. Dilger is relied upon in the outstanding Office Action for disclosure of "many asset management systems wherein a central database stores information on various assets held by an organization." *See Office Action*, pg. 6. It is further asserted that, in Dilger, "[u]sers of the organization access a website hosted by at least one server and transmit a service request to the server." *Id.* In addition, it is asserted that "Dilger discusses using the Internet." *Id.* at pg. 7.

Dilger is not enabled with respect to the systems or methods of claims 1, 20, 30, or 38. That is, significant and undue experimentation would be required to carry out the asserted invention in Dilger. Dilger merely discloses tidbits of information regarding specific companies and their plant maintenance systems. More specifically, the article merely provides a laundry list of various plant maintenance systems, but it certainly does not disclose the structure or operation of those systems in sufficient detail such that one of skill in the art could recreate any of the systems. For example, Dilger discusses, in very general terms, (1) the MAXIMO™ suite of products of PSDI (*see* pg. 2), (2) the Enterprise MPACT™ products of TSW International (*see* pg. 3), (3) the MaintainIt™ suite of products of Datastream Systems (*see* pg. 4), (4) the Immpower™ products of Revere (*see* pg. 5), and (5) the Compass™ products of Bonner & Moore. However, nowhere does Dilger describe or provide any information about the structure or operation of any such system in such a fashion that one of ordinary skill in the art would be

able to carry out any of those systems without undue experimentation. In fact, Dilger fails to even describe in sufficient detail for one of ordinary skill in the art how any of the servers or databases of the subject systems are configured to provide the relied-upon asset management, storage of asset information, or transmission of a service request.

For example, the discussion of PSDI's MAXIMO™ products discusses only the types of servers and databases that can be used with the products, not how the products are actually configured or whether or how the "asset information comprises information relating to ownership, maintenance, and repair of the pieces of equipment," as required in claim 1. Further, the description of the MAXIMO™ products does not discuss whether or how the product "tracks asset information relevant to determining a total cost of ownership for each asset, . . . wherein the asset information comprises information relating to ownership, maintenance and repair of the pieces of equipment," as required in claim 20. In addition, the description does not discuss whether or how the product stores asset information "wherein the asset information comprises information relating to ownership, maintenance and repair of each piece of equipment," or how it receives user specified requests for asset information and transmits the requested information to the client processor, as required in claim 30. Further, the description does not discuss whether or how the product has a "database containing asset information and service provider information" and receives service requests and automatically selects "an appropriate service provider based on the asset to be serviced," as required in claim 38.

In fact, Dilger fails to describe any system with sufficient clarity and detail for one of ordinary skill in the art to carry out the asserted invention in Dilger. As stated by the Federal Circuit, the issue is not whether Dilger is an accurate compilation of the state of the art at the time Dilger was published, but rather whether the disclosure enables a person of ordinary skill, without undue experimentation, to produce the desired system. *See Elan*, 346 F.3d at 1057. Mere recitation of known systems is not enough.

Thus, undue experimentation would be required for one of ordinary skill in the art to carry out the invention claimed in claims 1, 20, 30, or 38 using the disclosure of Dilger. As such, Dilger is not enabled and cannot be applied to reject claims 1, 20, 30, or 38. Reconsideration and withdrawal of the rejections are respectfully requested.

Given that McGovern is not actually discussed substantively in the Office Action and that none of its disclosure is actually relied upon for the rejections discussed above, Applicants question whether McGovern is still considered relevant to the present claims.

Regardless, McGovern also fails to remedy the deficiencies of Sims. That is, McGovern fails to teach or suggest a system or method wherein the physical condition of each asset is not determined based on the physical location of the asset. In fact, as discussed in Applicants' May 10, 2006 Response, McGovern merely discloses a system for selecting and training candidate employees for temporary or permanent employment at a customer's facilities. That is, McGovern is clearly a system and method for job placement. Nowhere does McGovern teach or suggest a system wherein the physical condition of each asset is not determined based on the physical location of the asset.

Thus, none of Sims, Dilger, or McGovern, alone or in combination, teach or suggest the inventions of claims 1, 20, 30, or 38. That is, none of Sims, Dilger, or McGovern or any combination thereof teaches or suggests a system wherein the physical condition of each asset is not determined based on the physical location of the asset. Reconsideration and withdrawal of the rejections are respectfully requested.

*Claim 38 Is Not Unpatentable Over Sims in view of Dilger and/or McGovern*

Additionally, claim 38 is also patentable over the cited prior art references for at least another reason. Claim 38 is directed to a method comprising, in part, "automatically selecting an appropriate service provider based on the asset to be serviced; and generating an electronic message to the appropriate service provider requesting service."

Sims does not teach or suggest the invention of claim 38. That is, nowhere does Sims teach or suggest automatically selecting an appropriate service provider and generating an electronic message requesting service. Instead, Sims, as discussed above, merely discloses a system that allows users, including external users, to manually request reports relating to various devices. Nowhere, however, does Sims teach or suggest automatically selecting an appropriate service provider and generating an electronic message requesting service. Thus, Sims does not teach or suggest the invention of claim 38.

Both Dilger and McGovern fail to remedy the deficiencies of Sims. That is, both Dilger and McGovern fail to teach or suggest a central processor "automatically selecting an



appropriate service provider based on the asset to be serviced; and generating an electronic message to the appropriate service provider requesting service.”

Thus, none of Sims, Dilger, or McGovern, alone or in combination, teach or suggest “automatically selecting an appropriate service provider based on the asset to be serviced; and generating an electronic message to the appropriate service provider requesting service.” As such, none of the references teach or suggest the invention of claim 38. Reconsideration and withdrawal of the rejection are respectfully requested.

*Claim 7 Is Not Unpatentable Over Sims in view of Dilger and/or McGovern*

Claim 7 is directed to the system of claim 1 wherein the “central processor is programmed with code for utilizing a user profile, including securable attributes, to limit access to particular asset information.”

Sims does not teach or suggest the invention of claim 7. Instead, the passage cited in the Office Action merely makes a blanket statement that other computers and peripheral devices allow system information “to be accessed throughout the hospital and from outside the hospital (by authorized users).” See *Sims*, col. 14, ll. 60-64. Nowhere does Sims discuss a user profile or securable attributes or utilizing such a profile including such attributes to limit access to particular asset information.

At best, the cited passage may mean that users outside the hospital must have authorization to access the computer or peripheral device discussed. However, even if true, nothing in the statement or the remainder of the Sims disclosure discloses limiting access to particular asset information. That is, without conceding the point, while the Sims system *may* include a standard password to limit access to the system to those with the password, nothing in Sims teaches or suggests limiting access to particular asset information. Thus, Sims fails to teach or suggest the invention of claim 7.

Both Dilger and McGovern fail to remedy the deficiencies of Sims. That is, both Dilger and McGovern fail to teach or suggest a central processor “programmed with code for utilizing a user profile, including securable attributes, to limit access to particular asset information.”

Thus, none of Sims, Dilger, or McGovern, alone or in combination, teach or suggest a central processor “programmed with code for utilizing a user profile, including securable attributes, to limit access to particular asset information.” As such, none of the references teach

or suggest the invention of claim 7. Reconsideration and withdrawal of the rejection are respectfully requested.

*Claim 11 Is Not Unpatentable Over Sims in view of Dilger and/or McGovern*

Claim 11 is directed to the system of claim 1 wherein the “central processor is programmed with code for determining an appropriate service provider for a particular asset and alerting the service provider of a service request.”

Sims does not teach or suggest the invention of claim 11. That is, nowhere does Sims teach or suggest a central processor programmed with code for determining an appropriate service provider for a particular asset and alerting the service provider. Instead, Sims merely discloses a system that allows users, including external users, to manually request reports relating to various devices. More specifically, the accessibility of the system through external telephones “enables device vendors and repair facilities . . . to query data management computer for information related to the various services that they provide.” *See Sims*, col. 16, l. 64 – col. 17, l. 2. The repair facility can utilize such a report request to “determine the types and quantities of devices that need repair.” Sims, however, fails to teach or suggest a central processor programmed with code for determining an appropriate service provider for a particular asset and alerting the service provider.

Both Dilger and McGovern fail to remedy the deficiencies of Sims. That is, both Dilger and McGovern fail to teach or suggest a central processor “programmed with code for determining an appropriate service provider for a particular asset and alerting the service provider of a service request.”

Thus, none of Sims, Dilger, or McGovern, alone or in combination, teach or suggest a central processor “programmed with code for determining an appropriate service provider for a particular asset and alerting the service provider of a service request.” As such, none of the references teach or suggest the invention of claim 11. Reconsideration and withdrawal of the rejection are respectfully requested.

*Claims Depending from Claims 1, 20, 30, and 38 Are Patentable*

Because claims 2-11, 13-14, 16-19, 21-29, 31-37, and 39-45 depend directly or indirectly from claims 1, 20, 30, or 38 and incorporate all the limitations of those claims, the above arguments obviate the bases for these grounds of rejection. Thus, claims 2-11, 13-14, 16-19, 21-

29, 31-37, and 39-45 are not unpatentable over Sims in view of Dilger and/or McGovern. Reconsideration and withdrawal of the rejections are respectfully requested.

### **New Claims**

New claims 49-59 have been added in the instant Response. It is respectfully submitted that none of Sims, Dilger, or McGovern, alone or in combination, teach or suggest the inventions of independent claims 49, 53, or 59.

Claim 49 is directed to a system comprising, in part, "defined access levels programmed into the central processor, wherein access of the user to the asset information is determined based on the defined access levels and a user profile of the user." Nowhere do Sims, Dilger, or McGovern teach or suggest defined access levels programmed into the central processor. Thus, claim 49 is patentable over Sims, Dilger, and/or McGovern.

Claim 53 is directed to a system comprising, in part, a central processor "wherein the central processor is configured to automatically identify an appropriate service provider for a particular asset based on the particular asset and the service provider information, and wherein the central processor is configured to automatically alert the appropriate service provider of a service request." Nowhere do Sims, Dilger, or McGovern teach or suggest such a central processor.

More specifically, nowhere does Sims teach or suggest automatically identifying an appropriate service provider or automatically alerting the appropriate service provider of a service request. Instead, as discussed above, Sims merely discloses a system that allows users, including external users, to manually request reports relating to various devices. Sims, however, fails to teach or suggest a central processor that automatically identifies an appropriate service provider or automatically alerts the appropriate service provider of a service request. Similarly, neither of Dilger or McGovern teach or suggest such a central processor. Thus, claim 53 is patentable over Sims, Dilger, and/or McGovern.

Claim 59 is directed to a system comprising, in part, "defined access levels programmed into the central processor, wherein access of a service provider to the asset information is determined based on the defined access levels and a profile of the service provider." Further, the claim is also directed to a system comprising, in part, a central processor "wherein the central processor is configured to automatically identify an appropriate service provider for a particular

asset based on the particular asset and the service provider information, and wherein the central processor is configured to automatically alert the appropriate service provider of a service request." As discussed above, nowhere do Sims, Dilger, or McGovern teach or suggest such a system. Thus, claim 59 is patentable over Sims, Dilger, and/or McGovern.

**CONCLUSION**

Applicants respectfully submit that claims 1-11, 13-14, 16-45, and 49-59 are in condition for allowance. Reconsideration and a Notice of Allowance for all pending claims are respectfully requested.

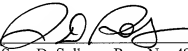
If any issues or concerns remain after consideration of the instant Response, Applicants request that the Examiner contact its undersigned representative at 612-340-7862 to schedule an in-person interview in the near future.

This Response is being submitted on or before April 16, 2006, with a Petition for a One-Month Extension of Time, and the required fees, making this a timely response. It is believed that no additional claim fees are due in connection with this filing. However, the Commissioner is hereby authorized to charge any fee deficiency, or credit any overpayment, associated with this paper to Deposit Account No. 04-1420.

Respectfully submitted,

**DORSEY & WHITNEY LLP**  
**Customer Number 25763**

Date: April 16, 2007

By:   
Sean D. Solberg, Reg. No. 48,653  
Phone: (612) 340-7862